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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

MUMTAZ SHAH

SERIAL NO.: 09/403,796

ART UNIT: 3724

FILED: OCTOBER 25, 1999

EXAMINER: CHARLES GOODMAN

TITLE: CUTTING SHEET MATERIAL

REPLY APPEAL BRIEF

In reply to the "Examiner's Answer," dated April 6, 2004, Applicant ("Appellant") hereby files his "Reply Appeal Brief," pursuant to 37 C.F.R. §1.193(b)(1) and M.P.E.P. §1208.03, in triplicate, as follows:

I. Related Appeals and Interferences

Appellant hereby affirms that there are no pending appeals or related interferences that would affect, or be affected by, or have a bearing upon, the decision in this appeal. This affirmation is consistent with Appellant's statement in his "Amended Appeal Brief" (at 2), filed February 19, 2003; and his "Request for Reinstatement of Appeal and Supplemental Appeal Brief" (at 2), filed August 8, 2003,

I hereby certify that this paper is being deposited this date with the U.S. Postal Service as First Class Mail addressed to: Hon. Commissioner for Patents, United States Patent and Trademark Office, P. O. Box 1450, Alexandria, VA 22313-1450.


Edwin D. Schindler, Reg. No. 31,459

June 7, 2004

Date

that "[t]here are no related appeals or interferences pending," and the Examiner's contention, expressed in his "Examiner's Answer" (at 2), that Appellant's Brief does not contain the statement required under 37 C.F.R. §1.92(c)(1), is clearly erroneous and simply not understood.

II. The "Freely Movable" Claim Limitation

The Examiner has contended, but has failed to explain why, "Appellant's argument in the ["Amended Appeal Brief," filed February 19, 2003], pp. 10-15, traversing *Ex parte Marsham* is not applicable in the current brief to the extent that a new grounds [sic] of rejection had been set forth in the last Office Action." See, "Examiner's Answer" at 5.

Ex parte Marsham, 2 USPQ2d 1647 (PTO Bd. of Pat. App. & Inter. 1987), was cited by the Examiner in the final Office Action at 2, para. 3; at 4, para. 7; at 6, para. 9 (3/26/02), for the contention that the claim terminology "freely movable," recited in Appellant's independent Claim 20 (and all remaining claims via dependency), was merely a statement of intended use and not a structural limitation entitled to patentable weight in Appellant's apparatus claims. The scope of the claim term "freely movable" is not altered, or to be interpreted differently, simply because the Examiner has modified the ground for rejection, and the applicability of the case law cited and argument presented by Appellant remains unchanged from that presented in Appellant's "Amended Appeal

Brief," filed February 19, 2003, at 10-15. The Examiner's statement that Appellant's prior argument concerning *Ex parte Marsham* is "not applicable" lacks merit and is frivolous in light of the Examiner's failure to explain his assertion.

The Examiner has again opined that the term "freely movable" is merely functional language entitled to "*de minimus*" patentable weight ("Examiner's Answer" at 5), but has failed to address Appellant's citation to *C.R. Bard Inc. v. M3 Systems Inc.*, 157 F.3d 1340, 48 USPQ2d 1225, 1229-1230 (Fed. Cir. 1998), in which the Federal Circuit construed the scope of a claim drawn to a biopsy needle, which included the term "free slidable," as part of the second sub-paragraph of the body of the independent claim under consideration. The term "free slidable" was used in the clause "a second needle extending through said hollow first needle and freely slidable therewithin." The limitation under review did not include "means for" claim language, which would have not been appropriate in such a claim, since an additional structure for such "means" would have been implied, but did not appear to exist. The Examiner has not sought to explain why "freely slidable" was a structural limitation in the claim before the Federal Circuit in *C.R. Bard*, entitled to patentable weight, but that "freely movable" in Appellant's claim is merely functional language entitled to only "*de minimus*" weight.

Likewise, the Examiner has not attempted to distinguish

Zeller Plastik, Koehn, Grabne & Co. v. Joyce Molding Corp., 698 F.Supp. 1204, 10 USPQ2d 1081, 1091-1092, 1096 (D.N.J. 1988), in which the district court granted a preliminary injunction against an alleged infringer of patent claims having the phrase "freely movable," from the case now presented to the Board.

The Examiner's opinion of the "*de minimus*" patentable weight that he feels "freely movable" should be accorded in Appellant's patent claims is appreciated, but is contrary to the established law and simply not relevant.

III. Applicant's Invention is "Freely Movable" in Both Linear and Non-Linear Directions, While the Marcoux Sheet Material Cutter is Only Linearly Movable

The Examiner has contended that the sheet material cutter disclosed by Marcoux is capable of both linear and non-linear cuts, referring to FIGS. 8 - 10 of Marcoux ("Examiner's Answer" at 5) or, in the alternative, if the sheet cutter in Marcoux is not capable of non-linear cuts, then it is unclear to the Examiner why Appellant's invention is capable of both linear and non-linear paths ("Examiner's Answer" at 6.)

The "Examiner's Answer" (at 6) cites to FIGS. 8 - 10 of Marcoux. FIG. 8 of the primary citation includes reference to the transverse cross-sectional view of FIG. 11, as seen along line 11 - 11 in FIG. 8. As best seen from the view of FIG.

11, reference numerals 31' denote "lateral sharp edges," as discussed at Col. 3, line 59 - Col. 4, line 6, of Marcoux. It is these "lateral sharp edges 31'," that are illustrated in FIGS. 8 - 11 of the primary citation as being parallel to one another, and which "may be displaced in either of the two longitudinal directions to cut a sheet of paper S" (Marcoux, Col. 6, lines 1-6), that compel the production of linear cuts from the sheet material cutter of Marcoux. That Marcoux further teaches that these lateral sharp edges may be "run against the lateral edge of a ruler 20, as shown in FIG. 11," only supports the logical and inevitable production of exclusively linear cuts from the parallel lateral sharp edges designated by reference numeral 31' in Marcoux. The sheet material cutter in Marcoux is, therefore, incapable of cutting sheet material in a non-linear manner!

In contrast to that disclosed by Marcoux, the lower part (11) of Appellant's invention is provided, at its front and rear ends, with respective groups of runners (15), in the form of inverted domes. These runners are, preferably, of a self-lubricating plastic material, such as PTFE, or of metal. It is these runners (15) which enable lower part (11) to move freely about a surface (16), such as a table, in both linear and non-linear directions. (See, Appellant's Specification at Page 3, line 20 - Page 4, line 3) While Appellant's invention may be linearly moved against the edge of a ruler, such as may the sheet material cutter disclosed by Marcoux, unlike

that shown in Marcoux. Appellant's cutter for sheet material does not include parallel lateral sharp edges on its underside which necessarily compel linear movement, regardless of whether placed up against a straight edge of a ruler. It is the runners (15), on the underside of the presently claimed invention, that allow for both linear and non-linear cuts by Appellant's sheet material cutter. This is how Appellant's invention differs from that disclosed by the prior art of Marcoux and why Appellant's invention - but not the sheet cutter taught by Marcoux! - is able to also move and cut in a non-linear manner.

IV. The Rejection of Claims 20-22 as Being Obvious Over Marcoux, Taken in View of Campbell, Jr.

Appellant continues to maintain that Campbell, Jr. is non-analogous art vis-a-vis the technical field of Appellant's invention, however, even if properly applicable in the obviousness rejection of record against Appellant's independent Claim 20 for its disclosure of "pressure means," which the Examiner has acknowledged is absent from the primary reference of Marcoux, Campbell, Jr., directed to a letter opener, and not a cutter of sheet material, can still not alter the fact that Appellant's invention, unlike that of Marcoux, can produce both linear and non-linear cuts. If one were to combine the teachings of Marcoux and Campbell, Jr. in the manner suggested by the Examiner, at best, one would arrive at a sheet cutter having "pressure means," but capable

of only linear cuts of sheet material; the combination of Marcoux, taken in view of Campbell, Jr., would not yield a sheet material cutter having "pressure means" and "freely movable in both linear and non-linear paths," as recited in independent Claim 20 of Appellant's patent application.

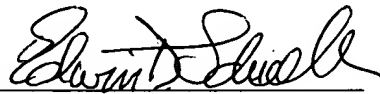
V. Summary

In summation, it is respectfully contended that all claims now pending in the above-identified patent application (i.e., Claims 20-24) recite a novel and efficient apparatus for cutting sheet material, which is freely movable in both linear and non-linear paths, which is patentably distinguishable over the prior art.

Accordingly, reversal of the Examiner's final rejection, pursuant to 35 U.S.C. §103(a), and the allowance of all claims now pending are respectfully requested and earnestly solicited.

Respectfully submitted,

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The Commissioner is hereby authorized to charge the Deposit Account of Appellant's Attorney, Account No. 19-0450, for any additional fees which may be due in connection with the prosecution of the present application, but which have not otherwise been provided for.